



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT(S) : P. Simmons, et al.  
SERIAL NO. : 10/030,411  
FILED : April 11, 2002  
FOR : Mesenchymal Precursor Cell  
GROUP ART UNIT : 1625  
Examiner : Belyavskiyi, Michail A.

Mail Stop: Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia, 22313-1450

**Election of Invention in Response  
to Restriction Requirement**

In response to the Examiner's correspondence dated January 12, 2005, pursuant to the Examiner's restriction requirement in the above-referenced patent application, Applicants provisionally elect with traverse to prosecute the invention of group II, namely claims 25-28, 31, 34, 40-45 and 47-58 (claims 1-24, 29-30, 32-33, 35-39 and 46 are cancelled without prejudice and claims 52-58 are newly added in the attached amendment) which are drawn to an enriched population of mesenchymal precursor cells and a composition comprising said cell. In addition Applicants provisionally elect with traverse to prosecute a species wherein the mesenchymal cells carry the antigen or marker STRO-1. Claims 25-28, 31, 34, 40-45, 47-53, and 58 as amended, are readable on the elected species.

Applicants respectfully traverse the Examiner's requirement for restriction. Applicants respectfully request the Examiner reconsider his restriction requirement regarding the species restriction in its entirety and allow the examination of all of claims 25-28, 31, 34, 40-45 and 47-58, as amended. Applicants respectfully submit that prosecution of all of amended claims in group II, namely claims 25-28, 31, 34, 40-45 and 47-58, without regard to the imposed species restriction will allow the Examiner to examine all those claims without being subjected to an

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undue burden as discussed hereinbelow.

According to M.P.E.P. §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a *serious burden* would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of the amended claims would not place such a serious burden on the Examiner as to require restriction. All of the originally restricted claims of Group II are directed to related, though patentably distinct mesenchymal cells having different markers or antigens which would not impose a heavy burden of examination on the part of the Examiner.

Thus, it is Applicants' view that any search the Examiner would need to conduct in examining the instant application of all the claims would not be unduly burdensome. That would not be to say that the examination would not be rigorous or even time-consuming, but that such effort would not meet the burden requirements of MPEP§803 in order to impose restriction. Moreover, the examination of all of the amended claims of Group II of the instant application would not place such a serious burden on the Examiner as to require restriction, especially in light of the administrative efficiency gained by doing all of the claims at the same time, especially given the close relationship of the subject matter.

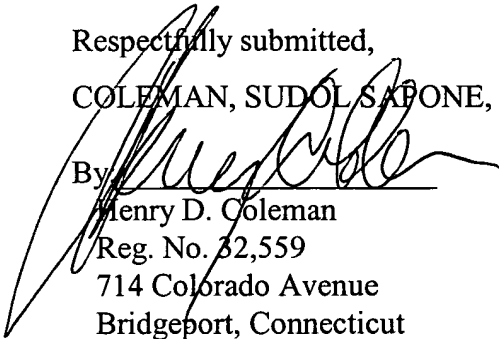
Applicants understand the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicants wish the Patent Office examine their patent application with a certain degree of "administrative efficiency" and wish to have patent claims issue which reflect the breadth of their invention.

Applicants respectfully submit that amended claims 25-28, 31, 34, 40-45 and 47-58, as a

group, are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in M.P.E.P. §803. Consequently, Applicant respectfully requests that the Examiner withdraw the species restriction/election requirement with respect to claims 25-28, 31, 34, 40-45 and 47-58.

The Examiner is cordially requested to call the undersigned attorney if the Examiner believes that a telephonic discussion may materially advance the prosecution of the instant application in any way. A petition for an extension of time of three months is enclosed as is the appropriate fee. The Commissioner is authorized to charge any deficiency in the fee or to credit any overpayment to deposit account 04-0838.

Respectfully submitted,  
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By   
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Dated: May 9, 2005

#### Certificate of Mailing

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia, 22313-1450, dated May 9, 2005.

  
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